

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ALIGN TECHNOLOGY, INC.

Plaintiff,

V.

3SHAPE A/S, 3SHAPE TRIOS A/S,
3SHAPE INC., and 3SHAPE
MANUFACTURING US, LLC

Defendants.

Redacted- Public Version

C.A. No. 18-1949-LPS

**ALIGN TECHNOLOGY, INC.'S MOTION TO DISMISS
COUNTERCLAIMS XI-XIII FOR LACK OF SUBJECT MATTER
JURISDICTION AND ON GROUNDS OF *FORUM NON CONVENIENS***

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Dated: October 6, 2020

Plaintiff Align Technology, Inc. (“Align”) moves to dismiss counterclaim Counts XI, XII, and XIII (D.I. 73) filed by defendants 3Shape A/S, 3Shape Trios A/S, and 3Shape Inc. (“3Shape”) for lack of subject matter jurisdiction under Federal Rule of Civil Procedure 12(b)(1) and on grounds of *forum non conveniens*. Align waives its opening brief and, for its motion, states as follows:

1. 3Shape’s counterclaims contain 13 claims, 10 arising under the patent laws (Counts I-X) and non-federal claims for unjust enrichment (Count XI), tortious interference with prospective business relations (Count XII), and unfair competition (Count XIII). (D.I. 73). These three non-federal claims are pleaded in threadbare fashion; set forth in just two pages of 3Shape’s 76-page answer and counterclaims, these claims make no suggestion about the governing law, other than two vague references to “common law”. As a result, Align initially moved to dismiss these claims for failure to state a claim under Federal Rule of Civil Procedure 12(b)(6). (*See* D.I. 74).

2. A few months later, 3Shape pleaded three nearly identical¹ non-federal claims in Civil Action 17-1648-LPS (the “1648 Action”) (*compare* D.I. 73, Counterclaim Counts XI, XII, and XIII *with* 1648 Action, D.I. 97, Counterclaim Counts XIII, XIV, and XV). 3Shape also joined a new breach of contract claim (Count XVI) to its three previously pleaded non-federal claims. (*See* 1648 Action, D.I. 97, Counterclaim ¶¶52-114). The contract at issue in Count XVI – which 3Shape appended to and made part of its claims – brought to the fore the question of whether any of 3Shape’s non-federal claims should be heard in the United States judicial system. That contract contains a [REDACTED]

¹ 3Shape deleted the word “and” from paragraph 40 of its unjust enrichment claim.

[REDACTED]

[REDACTED] (See *id.*, Exh. A § 18 ([REDACTED])

[REDACTED]

3. Align accordingly moved to dismiss Counts XIII-XVI in the 1648 Action under the doctrine of *forum non-conveniens*. (1648 Action, D.I. 103). Rather than repeat these arguments to support this motion to dismiss under the doctrine of *forum non-conveniens*, Align incorporates by reference the Statement of Facts (pages 2-4) and Argument (page 4-11) from Align's opening brief in the 1648 Action (1648 Action, D.I. 104).

4. 3Shape's counterclaims in the 1648 Action also contained no allegation of subject matter jurisdiction that would enable the Court to hear 3Shape's non-federal claims. For this reason as well, Align moved to dismiss Counts XIII-XVI in the 1648 Action for lack of subject matter jurisdiction.

5. Just as in the 1648 Action, 3Shape's counterclaims here contain no allegation of subject matter jurisdiction that would enable the Court to hear 3Shape's non-federal claims. (See D.I. 73, Counterclaim ¶ 6 (alleging subject matter jurisdiction under 28 U.S.C. §§ 1331 (federal question), 1338 (patent), 2201 (declaratory judgment), & 2202 (declaratory judgment)). (See also 1648 Action, D.I. 104 at 11-13).

6. The only possible basis of subject matter jurisdiction for Counts XI-XIII is the supplemental jurisdiction statute, 28 U.S.C. § 1367. But, as explained in detail in Align's opening brief in support of its motion to dismiss in the 1648 Action, § 1367 does not permit the Court to adjudicate these claims. (1648 Action, D.I. 104 at 13-16).

7. Align set forth each of these points in detail in its motion to dismiss in the 1648 Action. Rather than repeat these arguments to support this motion to dismiss for lack of subject

matter jurisdiction, Align again incorporates by reference the Argument (pages 11-16) from Align's opening brief in the 1648 Action (1648 Action, D.I. 104).

NOW, THEREFORE, plaintiff Align Technology, Inc. respectfully requests the Court to grant this motion and to enter the attached order dismissing Counterclaims XI, XII, and XIII.

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CERTIFICATE OF SERVICE

I, John W. Shaw, hereby certify that on October 6, 2020, this document was served by email to 3Shape_1949_Pepper@Troutman.com.

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